

by the examiner in support of the patentability of the present application.

Claim Rejections-35 U.S.C. 112

Claims 16-19 were rejected under 35 U.S.C. 112(1). Applicants respectfully traverse the rejection. It was asserted that the specification "does not reasonably provide enablement for one coolant nozzle discharging a plurality of liquid streams." It was asserted that particular outlet shapes for discharging more than one stream "are neither recited in the claims, nor disclosed in the specification." Office action, page 2, ¶3. However, this latter statement is unrelated to whether or not something is enabled and is also irrelevant because Applicants do not specifically claim multiple streams. Applicants merely do not wish the claim coverage to be unreasonably interpreted as precluding that situation. Nevertheless, the present application is not non-enabling. If one wished to discharge multiple streams from a given outlet, one could achieve this with routine experimentation.

Claim 15 was rejected under 35 U.S.C. 112(2). Applicants respectfully traverse the rejection.

It was asserted as "unclear what structure or element is being claimed by 'outlets provide a redundant coverage.'" The subject matter is believed clear. The sprays provide coverage around the entire circumference of the bit and the redundancy is effective so that blocking of at least one spray does not remove such coverage (see also ¶0017, final sentence). If the examiner believes alternative wording is appropriate, he is requested to contact the undersigned to discuss.

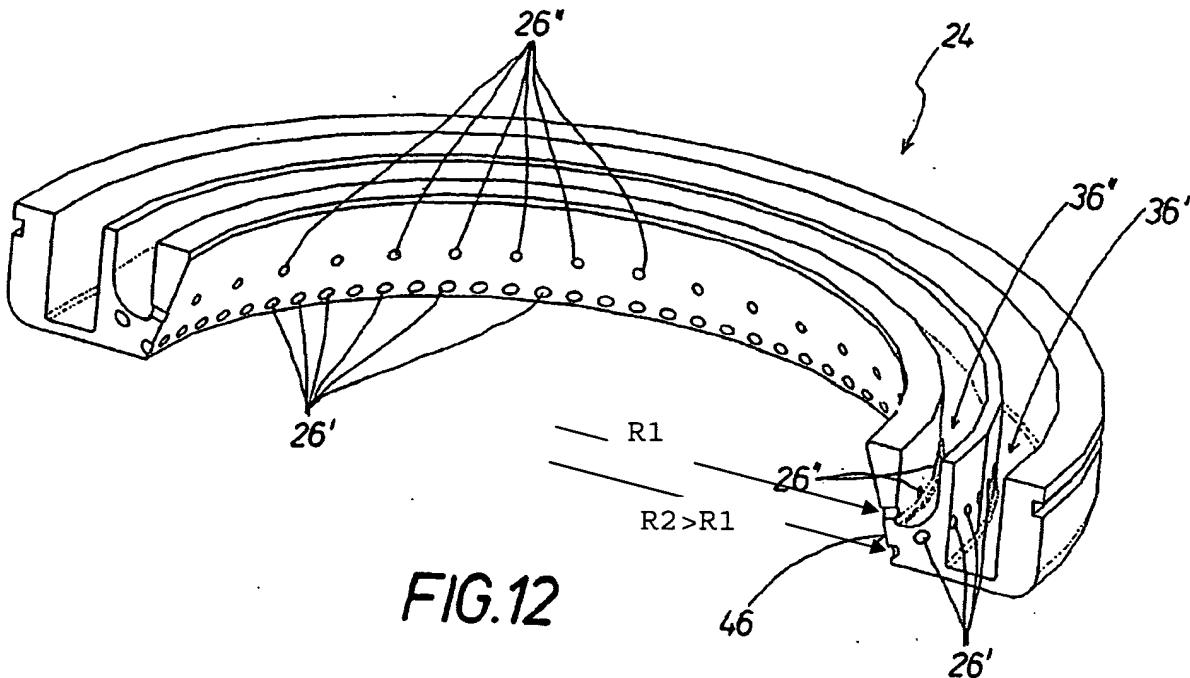
Claim Rejections-35 U.S.C. 102

Claims 10, 11, and 13-15 were rejected under 35 U.S.C. 102(e) as being anticipated by DE 202 16 396. Applicants respectfully traverse the rejection.

Claim 10 identifies the presence of an elongate abrasive bit. There is no suggestion for DE '396 having such an elongate bit. DE '396 involves a polishing disk for polishing the edges of flat glass panels. Accordingly, DE '396 cannot anticipate claim 10.

Also, the two apparent groups of outlets 26' and 26" are at different radial positions as shown below. This precludes both groups being applied to the claims and the "no other" element

of claim 10 precludes the possibility that only one of these two groups is applied while the other is ignored. Accordingly, DE '396 all the more cannot anticipate claim 11.



Claims Rejections-35 U.S.C. 103

Claims 1-11, 13-16, and 18-26 were rejected under 35 U.S.C. 103(a) as unpatentable over Reitmeyer (US6471573). Applicants respectfully traverse the rejection.

In the last full paragraph of page 4, it was asserted that Reitmeyer recited "any desired number of such outlet ports... may be located in any desired positions..." However, the Office's position mistakenly treats this passage as if it had disclosed all numbers and positions of outlets. If this were the case, the Office should simply close the art unit because no further nozzle patents will never be granted. Clearly, Reitmeyer might enable some scope of variations beyond its particular illustrated embodiment. However, there is no suggestion that it would enable or otherwise render obvious the presently-claimed invention.

It was asserted that the changed shape involves only routine skill in the art. There is no support for this erroneous statement. Furthermore, the citation to *In re Stevens* is irrelevant because *Stevens* does not support that proposition. There is no support for the erroneous assertion

that one would make the claimed shape changes merely based upon workpiece parameters.

Furthermore, in the first full paragraph of page 5, it was asserted that:

"sintered body, is not germane to the issue of patentability of the device itself. However, sintering to make the device last longer and/or to protect it against corrosion, is known in the art and such modification would have been well within the knowledge of one of ordinary skill in the art."

This erroneous statement is without substantiation and citation. There is no indication that one of ordinary skill in the art would provide Reitmeyer with a sintered body, let alone that the sintered body would either make Reitmeyer last longer or protect it against corrosion in the Reitmeyer application. If anything, the opposite would be the case.

In the second full paragraph of page 5, the Office action further bootstraps a previously made argument. There is no indication that Reitmeyer discloses the use of a superabrasive bit.

Reitmeyer's FIG. 4 clearly shows that it is not workpiece configuration that keeps Reitmeyer's coverage to a small non-redundant circumferential extent. No part of the workpiece is shown blocking the remaining area of the circumference.

Regarding claim 19, the examiner cited *In re Leshin*. However, *Leshin* is inapposite. *Leshin* involved a claim to a molded plastic container. Although one reference was a metal container, a second reference was plastic: "...Anderson shows a similar container of molded plastic and applicant concedes that the plastics he uses are well known..." 125 USPQ 417. In the present case, there is no similar sintered coolant nozzle to that presently claimed. There is no suggestion that one of ordinary skill in the art to which the present invention most closely pertains would have selected a sintered material generally, or a sintered ceramic particularly.

Claims 10, 11, and 13-15 were rejected under 35 U.S.C. 103(a) as unpatentable over Reitmeyer either alone or in view of DE'396.

This is merely a hindsight reconstruction of the present invention. The attempted modification of Reitmeyer, if possible, would greatly increase Reitmeyer's already high complexity and manufacturing cost. This is evidenced by the number of parts and machining steps required just to provide the three outlets of Reitmeyer. This further confirms the non-obviousness of the present invention.

Claims 1-9, 16, and 18-26 were rejected under 35 U.S.C. 103(a) as unpatentable over Reitmeyer in view of Perkins et al. (US4252768). Applicants respectfully traverse the rejection.

There is no suggestion for the proposed combination. This is merely a hindsight reconstruction. There is no suggestion that one of ordinary skill in the art would seek Perkins et al. or, if presented with Perkins et al. choose any modification based thereon. Perkins et al. involves considerations particular to sandblasting nozzles and not coolant nozzles. The ceramic core of Perkins et al. appears chosen for interfacing with the sandblasting medium which requires abrasion resistance and high temperature resistance. There is no suggestion that these properties are appropriate for coolant use. There is no suggestion to use it for coolant. There is furthermore no suggestion that one, if using Perkins et al., would make the claimed nozzle as a single piece. For example, if molded, one would effectively duplicate the multiple pieces of Reitmeyer with multiple ceramic pieces, potentially needing further housing structure to hold them together. There is no indication that the single piece nature of Perkins et al. core (as distinguished from the nozzle of Reitmeyer) would be preserved in making more complex structure.

Claims 1-9, 16, and 18-26 were rejected under 35 U.S.C. 103(a) as being unpatentable over DE '396 either alone or in view of Perkins et al. Applicants respectfully traverse the rejection.

This rejection suffers from the same deficiencies as do the underlying DE '396 rejection and the Reitmeyer in view of Perkins et al. rejection.

Accordingly, Applicants submit that claims 1-8, 10, 11, 13-16, 18-26 are in condition for allowance. Please charge any fees or deficiency or credit any overpayment to our Deposit Account of record.

Respectfully submitted,

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Date: October 2, 2006

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on October 2, 2006

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